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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,339	05/04/2001	Gideon Fostick	Q63704	6762

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EXAMINER

DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,339

Applicant(s)

FOSTICK ET AL.

Examiner

Willie J. Daniel, Jr.

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/04/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 04 May 2001 is in compliance with the provisions of 37 CFR 1.97 and is being considered by the examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: **Fig. 2** has (**ref. 1030**), (**ref. 1035**), (**ref. 1040**) which are not included in specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The specification has **hyperlinks** on pg. 5, lines 1-2, 10, 19.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 5-8, 11, 12, 14-18 are rejected under 35 U.S.C. 102(a) as being anticipated by **Takala (WO 99/53699)**.

Regarding **Claim 1**, Takala discloses a system (Fig. 1) for managing at least one SMS message by at least one message receiver (DTE), comprising:

i. an SMS Center (SMSC) for handling and processing the at least one SMS message for the at least one message receiver (DTE) (see pg. 6, lines 10-21; Fig. 1 (ref. “2” and “SMSC”));

ii. an Auto-Reply Message Server (ARMS) (3) for storing and managing at least one Auto-Reply Message for the message receiver (DTE) (see pg. 6, lines 16-27; Fig. 1).

Regarding **Claim 2**, Takala discloses a system further comprising an SMS Automatic Handling Server (SAHS) for handling at least one message instruction for the message receiver (DTE) (see pg. 7, lines 20-24; Fig. 1).

Regarding **Claim 5**, Takala discloses a system, wherein said ARMS includes:

a mechanism for enabling said at least one message receiver (DTE) to set up and manage at least one automatic reply message (see pg. 6, lines 16-27);

a database (3) for maintaining said at least one automatic reply message for said at least one message receiver (DTE) (see pg. 6, line 16-27; Fig. 1); and

a server (2) for serving said at least one automatic reply message to said SMSC (see pg. 6, lines 16-27; Fig. 1).

Regarding **Claim 6**, Takala discloses a system (Fig. 1), wherein said SAHS includes:

a. a mechanism for enabling said message receiver (DTE) to set up and manage at least one alternative handling instruction (see pg. 7, lines 20-36);

b. at least one database (3) for maintaining said at least one alternative handling instruction for said at least one message receiver (DTE) (see pg. 7, line 20-36), where the user is able to setup additional instructions based on certain numbers, identifiers, and fields; and

c. a server (2) for serving said at least one alternative handling instruction to said SMSC, (see pg. 7, line 20 - pg. 8, line 2).

Regarding **Claim 7**, Takala discloses a system (Fig. 1) for managing at least one SMS message by at least one message receiver (DTE), comprising (pg. 6, line 16-27):

i. an SMS Center (SMSC) for handling the at least one SMS message for the at least one message receiver (see pg. 6, line 10-29; Fig. 1); and

ii. an SMS Automatic Handling Server (SAHS) for executing at least one message instruction for the at least one message receiver (DTE) (see pg. 7, lines 20-24; Fig. 1), where the user is able to setup a message based on alternative instructions that will provide information from certain fields.

Regarding **Claim 8**, Takala discloses a system (Fig. 1) wherein said SMSC includes an Auto-Reply Message Server (ARMS) for storing and managing at least one Auto-Reply Message for the at least one message receiver (DTE) (pg. 6, line 12-29; Fig. 1 "ref. 3"),

where the SMSC is capable of storage and delivery functions of short messages and automated responses.

Regarding **Claim 11**, Takala discloses a method of automatically replying to SMS messages, comprising:

- i. setting up at least one automated reply message on an Automated Reply Message Server (ARMS) (see pg. 6, lines 16-29; Fig. 1 “ref. 2”);
- ii. querying said ARMS in response to receiving an SMS message, to determine whether there is at least one automated reply message to be executed, by an SMS Center (SMSC) (see pg. 6, lines 16-21; pg. 7, lines 24-28; Fig. 1), where querying of database 5 to determine which user information to retrieve;
- iii. where there is no automated reply message, sending said SMS message to said SMS message's destination, by said SMS center (see pg. 7, lines 20-24; pg. 8, lines 19-21), where the subscriber has the option of setting up and storing a message in the answering server in cases where no message is stored calls will be transferred to the subscriber's terminal as done in normal operation;
- iv. if there is an automated reply message, sending said automated reply message to said SMS center, by said ARMS (see pg. 6, lines 10-27; pg. 7, lines 24-28; Fig. 1), where the SMSC handles delivering of messages; and
- v. if there is more than one automated reply message, sending to said ARMS said SMS message, such that said message acts as an identifier, which reads on the claimed “key” for choosing an appropriate automated reply message, and such that said ARMS returns to said SMS Center said appropriate automated reply message (see pg. 7, lines 29 - col. 8, line 22),

where the identifier is recognized to deliver a specific response in accordance to what the subscriber has setup in the fields.

Regarding **Claim 12**, Takala discloses a method wherein said SMS message received is a "trigger message", enabling triggering off at least one ARM (see pg. 7, lines 29 - col. 8, line 22), where the identifier is recognized to deliver a specific response in accordance to what fields the subscriber has setup.

Regarding **Claim 14**, Takala discloses a method, wherein said setting up of at least one automated reply message is performed by using a mechanism selected from the group consisting of:

- I. a form on a Web-based interface (see pg. 7, lines 6-13); and
- II. a SMS message sent to said ARMS from a communications device (see pg. 7, lines 14-19; Fig. 1), where a message or call from A-subscriber is being transferred to the answering server 2 of B-subscriber.

Regarding **Claim 15**, Takala discloses a method of managing SMS messages, comprising (see pg. 6, line 16-27; Fig. 1):

- a. setting up at least one alternative handling instruction on an SMS Automatic Handling Server (SAHS), by at least one message receiver (see pg. 7, lines 12-36; Fig. 1);
- b. sending a message to said message receiver (DTE), by a message sender (see pg. 7, lines 12 - pg. 8, line 22; Fig. 1);
- c. querying said SAHS to determine whether there is an alternative handling instruction to be executed for said message, by an SMS Center (SMSC) (see pg. 7, lines 12 - pg. 8, line

22; Fig. 1), where the querying of databases 3 and 5 to determine which user information to retrieve in order to carry out the alternative handling instruction;

d. where there is no alternative handling instruction, sending said message to said message receiver, by said SMS center (see pg. 7, lines 20-24, pg. 8, lines 19-22), where the subscriber has the option of storing and setting up a reply message based on alternative instructions in the answering server and for instances when no message is stored calls will be transferred to the subscriber's terminal as done in normal operation;

e. if there is at least one alternative handling instruction, serving said one alternative handling instruction to said SMS center (SMSC) (see pg. 6, lines 10-27; pg. 7, lines 12 - pg. 8, line 22; Fig. 1), where the SMSC handles the delivering of messages.; and

f. executing said appropriate alternative handling instruction, by said SMS center (see pg. 7, lines 20-36; Fig. 1), where the user is able to setup a message based on alternative instructions and provide specific information from the fields.

Regarding **Claim 16**, Takala discloses a method wherein said at least one alternative handling instruction is selected from the group consisting of automatic replying, automatic forwarding, automatic deleting and automatic filtering (see pg. 7, lines 20-36).

Regarding **Claim 17**, Takala discloses a method wherein said setting up one or more automated reply messages is performed by using a mechanism selected from the group consisting of:

One) a form on a Web-based interface (see pg. 7, lines 6-13); and

Two) at least one SMS message sent to said SAHS from a communications device (see pg. 7, lines 14-19; Fig.1), where a message or call from A-subscriber is being transferred to the answering server (2) of B-subscriber.

Regarding **Claim 18**, Takala discloses a method of claim 15, wherein said at least one alternative handling instruction is configured to be sent to at least one group of message senders (see pg. 7, lines 20-36), where an identifier is recognized to deliver a specific response in accordance to what fields the recipient or subscriber has setup.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 10, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Takala (WO 99/53699)** in view of **Lahtinen (US 5,351,235)**.

Regarding **Claim 3**, Takala teaches of having a system that performs automatic response according to instructions with the functionality being provided by software and different elements (see pg. 6, lines 16-29; pg. 7, lines 20-36). Takala fails to disclose having a SAHS located within the SMSC. However, the examiner maintains that having a SAHS located within the SMSC was well known in the art, as taught by Lahtinen.

In the same field of endeavor, Lahtinen teaches of having the software and other elements such as the functions of the SAHS located within the SC, which reads on the claimed "SMSC" (see col. 4, lines 7-11; col. 5, lines 60-64; Figs. 1, 2, 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lahtinen to have a system wherein said SAHS is located within said SMSC.

The advantage of combining the teachings of Takala and Lahtinen is to have a network in which a message switching service is provided for subscribers that will allow the short message service center (SC) as a part of the service to provide receiving and

transmitting of messages in digital form on the basis of the so-called “store and forward” principle, from one mobile phone to another mobile phone.

Regarding **Claim 4**, Takala teaches of having a system that performs automatic response according to instructions with the functionality being provided by software and different elements (see pg. 6, lines 16-29; pg. 7, lines 20-36). Takala fails to disclose having an ARMS located within the SMSC. However, the examiner maintains that having an ARMS located within the SMSC was well known in the art, as taught by Lahtinen.

Lahtinen further teaches of having the software and other elements such as the functions of the ARMS located within the SC, which reads on the claimed “SMSC” (see col. 4, lines 7-11; col. 5, lines 60-64; Figs. 1, 2, 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lahtinen to have a system wherein said ARMS is located within said SMSC.

The advantage of combining the teachings of Takala and Lahtinen is to have a network in which a message switching service is provided for subscribers that will allow the short message service center (SC) as a part of the service to provide receiving and transmitting of messages in digital form on the basis of the so-called “store and forward” principle, from one mobile phone to another mobile phone.

Regarding **Claim 9**, Takala teaches of having a system for managing at least one SMS message by at least one message receiver (DTE), comprising: i. an SMS Center (SMSC) for handling at least one SMS message for at least one said message receiver (DTE) (see pg. 6, line 12-29; pg. 7, 20-36; Fig. 1), where the SMSC handles the delivering of

messages. Takala fails to disclose having one component including both the ARMS and SAHS. However, the examiner maintains that having an ARMS and SAHS located within the SMSC was well known in the art, as taught by Lahtinen.

Lahtinen further teaches of having a component including an Auto-Reply Message Server (ARMS) for storing and managing at least one Auto-Reply Message for said message receiver, and an SMS Automatic Handling Server (SAHS), for handling at least one message instruction for said message receiver (SMT) (see col. 4, lines 7-11; col. 5, lines 60-64; Fig. 6 “ref. SC”), where one component (SC) includes software and other elements to provide functions such as those of the ARMS and SAHS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lahtinen to have a system for managing at least one SMS message by at least one message receiver, comprising: i. an SMS Center (SMSC) for handling at least one SMS message for at least one said message receiver; and ii. a component including an Auto-Reply Message Server (ARMS) for storing and managing at least one Auto-Reply Message for said message receiver, and an SMS Automatic Handling Server (SAHS), for handling at least one message instruction for said message receiver.

The advantage of combining the teachings of Takala and Lahtinen is to have a network in which a message switching service is provided for subscribers that will allow the short message service center (SC) as a part of the service to provide receiving and transmitting of messages in digital form on the basis of the so-called “store and forward” principle, from one mobile phone to another mobile phone.

Regarding **Claim 10**, the combination of Takala and Lahtinen disclose everything claimed, as applied above (see claim 9), in addition Takala further teaches to have a system, wherein said ARMS (2) and said SAHS (3) are separate databases or servers which reads on the claimed “entities” (see pg. 6, lines 16-27; pg. 7, lines 20-36; Fig. 1), where the information needed is provided by separate databases.

Regarding **Claim 19**, Takala teaches of a system for managing at least one SMS message by at least one message receiver (DTE), such that the message is delivered to a group of message senders, comprising: an SMS Center (SMSC) for handling the SMS message for the at least one said message receiver (see pg. 6, line 12-29; pg. 7, 20-36; Fig. 1), where the SMSC handles the delivering of messages. Takala fails to disclose having one component including both the ARMS and SAHS. However, the examiner maintains that having a component including both the ARMS and SAHS was well known in the art, as taught by Lahtinen.

Lahtinen further teaches of having a component including an Auto-Reply Message Server (ARMS) for storing and managing at least one Auto-Reply Message for said message receiver, and an SMS Automatic Handling Server (SAHS), for handling at least one message instruction for said message receiver (SMT), such that said instruction pertains to at least one group message (see col. 4, lines 7-11; col. 5, lines 60-64; Fig. 6 “ref. SC”), where one component (SC) includes software and other elements to provide functions such as those of the ARMS and SAHS.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lahtinen to have a system

for managing at least one SMS message by at least one message receiver, such that the message is delivered to a group of message senders, comprising: i. an SMS Center (SMSC) for handling the SMS message for the at least one said message receiver; and ii. a component including an Auto-Reply Message Server (ARMS) for storing and managing at least one Auto-Reply Message for said message receiver, and an SMS Automatic Handling Server (SAHS), for handling at least one message instruction for said message receiver, such that said instruction pertains to at least one group message.

The advantage of combining the teachings of Takala and Lahtinen is to have a network in which a message switching service is provided for subscribers that will allow the short message service center (SC) as a part of the service to provide receiving and transmitting of messages in digital form on the basis of the so-called "store and forward" principle, from one mobile phone to another mobile phone.

Claim 13 is rejected under 35 U.S.C. 103(a) as being obvious over **Takala (WO 99/53699)** in view of **Lohtia et al. (US 6,560,456)**.

Regarding **Claim 13**, Takala teaches of having automated reply messages being sent to the sender upon receiving a SMS message (see pg. 6, lines 16-27; pg. 7, lines 20-36). Takala fails to disclose having the SMS original message included in the response. However, the examiner maintains that having a SMS original message included in the response was well known in the art, as taught by Lohtia et al.

In the same field of endeavor, Lohtia et al. teaches of having the SMS original message sent back to the sender with the response (see col. 3, lines 52-56; Fig. 4), where the

user sends a requests via a SMS original message in which the response is returned to the user with the SMS original message included.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Takala and Lohtia et al. to have a method further comprising sending said SMS message together with said at least one automated reply message, to a message sender, by said SMS center.

The advantage of combining the teachings of Takala and Lohtia et al. is to provide a wireless network that allows subscribers with the capability to request particular types of SMS messages at to anytime.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takala (US 6,622,021) discloses a *System and Method For Implementing an Automated Communication Response Service*.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (703) 305-8636. The examiner can normally be reached on 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-3180.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-5424.

Marsha D Banks-Harold

WJD,JR/wjd,jr
09 December 2003

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